REMARKS

Applicants' affirm the provisional election made by Applicants' Attorney to prosecute group I and withdraws, without prejudice, claims 53 to 65 from further prosecution.

Applicants have revised the abstract to reflect the subject matter of the claims presently under consideration and to correct the spelling of "alumoxanes".

Applicants have amended claim 10 by incorporating therein the subject matter of former claims 11, 14, 15, and 16. In the portion of claim 14 incorporated into claim 10, applicants have amended "may be" to --is--, and have amended the clause "a halogen atom, preferably a chlorine or fluorine atom" to read --a chlorine or fluorine atom--. In claim 10 applicants have incorporated the subject matter of former claim 11 so it is clear what "M" is. Additionally, in the portions of claim 14 incorporated into claim 10 applicants have amended the ";" to --,--. Throughout amended claim 10 applicants have used the language --selected from the group consisting of--.

Claims 12 through 16 and 35 through 52 have been cancelled and claims 53 through 65 have been withdrawn.

It is respectfully submitted the revised claims meet the requirements of 35 U.S.C. §112.

The Examiner rejected the claims formerly on file pursuant to 35 U.S.C. §102 or 103 in view of United States Patent 5,990,035 issued November 23, 1999. Applicants respectfully traverse the Examiner's rejection. The applied reference teaches a catalyst system comprising:

a) a cocatalyst prepared by reacting a suitable support with an organo-aluminum compound and reacting that product with an activity promoting amount of water (Col. 2 lines 15-20, and 60 to 68; Col. 3 lines 63 to Col. 4 line 35; Col. 6 line 42; Col. 7 lines 28 to 30 and 45 to 55; Col. 8 lines 31 and 32, and 55 to 57; Col. 9 lines 17 to 19 and 42 to 45); and

b) a catalyst which may be a conventional Ziegler Natta catalyst (Col. 4 lines 36 to 50) and metallocene catalysts (Col. 4 lines 56 – Col. 5 line15 and the examples.)

The applied reference fails to teach the phosphinimine catalyst systems of the present invention.

The requirements for a prior reference to sustain a rejection pursuant to 35 U.S.C. §102 have been judicially considered in *Kahman v. Kimberly - Clark Corp.* 218 USPQ 781 (Fed. Cir. 1984) and *Leinoff v. Louis Milona & Sons, Inc.* 220 USPQ 845 (Fed. Cir. 1984). A reference, to be anticipatory under § 102, must meet every critical element of the claim at issue. That is, each element of a claim under consideration must be found in a single prior art reference. *Lindemann Maschinenfabrik, GMBH v. American Hoist & Derrick Co.,* 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

The applied reference fails to teach the phosphinimine catalyst of the present invention. Additionally the applied reference teaches against the formation of the alumoxane prior to supporting it on the support. It is respectfully submitted the applied reference fails to identically disclose the subject matter of the claims presently under consideration. It is respectfully submitted the revised claims are patentable in view of 35 U.S.C. §102 and the applied reference.

The application of 35 U.S.C. §103 to the issue of patentability has been considered by the Supreme Court of the United States in Graham v. John Deere 148 USPQ 459. The Supreme Court held that 35 U.S.C. §103 requires a three-pronged inquiry. It is necessary to:

(i) determine the knowledge disclosed in the prior art;

(ii) determine the differences between the teaching of the prior art and the claims at issue; and

(iii) resolve the differences between the teaching of the prior art and the claims in question on the level of the ordinary skill in the art field.

The teaching of the applied reference has been discussed above. The applied reference teaches away from the direct addition o the alumoxane to the support as required by the claims presently under consideration (see the comparative examples). There is no way one of ordinary skill in the art could resolve this contrary teaching with the claims presently under consideration without invention. Additionally, the reference fails to teach the phosphinimine catalyst of the present invention. The applied reference cites two patents, neither of which teaches phosphinimine catalyst of the present invention. The examiner has failed to make out a *prima facie* case of obviousness because he has used a legal conclusion as evidence. Inventions are obvious over references and the examiner has not cited any reference to support his legal conclusions regarding water addition in the present process. (See *In re Bezombes*, 164 USPQ 387, 391 (CCPA 1970). Silence in a reference is not a proper substitute for an adequate disclosure of facts. *In re Burt*, 148 USPQ 548 (CCPA 1966). It is well settled that a rejection based on § 103 must rest upon a factual basis rather

than conjure or speculation. "Where the legal conclusion of [of obviousness] is not supported by the facts it cannot stand." *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967); see also *In re Sporck*, 301 F.2d 686, 690, 133 USPQ 360,364 (CCPA 1962).

In view of the foregoing it is respectfully submitted the claims presently under consideration demonstrate inventive merit in view of the applied reference and the above noted test. Reconsideration of the rejection is respectfully solicited.

It is respectfully submitted the revised claims are patentably distinct over the applied reference and that the application is in good order for allowance and the same is respectfully solicited.

Respectfully submitted,

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